No. 15,893

IN THE

United States Court of Appeals

FOR THE NINTH CIRCUIT

CEE-BEE CHEMICAL CO., INC., a corporation,

Appellant,

vs.

DELCO CHEMICALS, INC., a corporation,

Appellee.

PETITION FOR REHEARING.

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To the Honorable Circuit Judges Hamley, Hamlin, and Jertberg of the United States Court of Appeals for the Ninth Circuit:

Now comes Appellee (plaintiff in the declaratory relief action below) and petitions this Honorable Court for a rehearing of the above-entitled appeal on the ground that errors of fact and law appear in the opinion filed December 22, 1958, in accordance with which a judgment or decree was filed and entered reversing the judgment of the Court below and remanding the cause for trial; correction of said errors of fact and law would necessarily lead to a different conclusion and an affirmance of the summary judgment of the lower Court holding invalid Appellant-Defendant's patent in suit.

The grounds upon which this petition is based are as follows:

1. In holding that the trial court had resolved a disputed question of fact which was a necessary predicate to the conclusion that the Whitcomb patent was invalid,

the Court gave full credence to an affidavit of the inventor Whitcomb which showed on its face that it lacked the credibility necessary to raise a *genuine* issue as to a material fact;

2. In holding that the Whitcomb affidavit raised a genuine issue as to a material fact, the Court overlooked the fact that said affidavit contradicts the clear teachings of the patent in suit and so should have been disregarded because the inventor is estopped to attack the validity of his own patent;

3. The Court erroneously applied the rule of *Bergman v. Aluminum Lock Shingle Corp. of America* (C. A. 9), 251 F. 2d 801, in the light of Section 103 of Title 35, United States Code, in denying to the court below the power to decide the pure question of law as to whether any difference between the claimed subject matter and the prior art is such as to amount to invention within the meaning of the patent statutes; and

4. The Court erroneously concluded (despite express findings and conclusions to the contrary) that the trial court had been presented with genuine issues of material fact, both as to the prior art and the teaching of the Whitcomb patent, which it had resolved against the contested patent, apparently overlooking the fact that in finding lack of invention, the trial court held, properly and as a matter of law, that the method claimed, while involving some novelty, nonetheless lacked invention over prior art as to which no issue existed.

It is apparent from the Court's opinion that Appellee failed to emphasize sufficiently the above-mentioned matters of fact and law. It is to rectify that error that this petition is presented, so that the Court may be fully advised of the facts and circumstances entitling Appellee to a judicial declaration that the Whitcomb patent is invalid.

ARGUMENT.

Whitcomb Affidavit Does Not Raise a Genuine Issue as to a Material Fact.

The Court's opinion and judgment on this appeal was predicated on the assumption that the Whitcomb affidavit raised a genuine issue as to a material fact, which issue precluded favorable action on Appellee's motion for summary judgment. While the Whitcomb affidavit *appears* to raise a factual issue, Appellee submits that it does not actually do so—any such issue it might raise is not genuine.

The alleged issue in question concerns the inquiry as to whether the Foster patent No. 1,141,243 discloses the so-called "second step" of the Whitcomb patent in suit. This inquiry concerns only claims 1, 2, and 3; claims 4 through 8 do not recite the second step, and as to them there can be no issue. According to claims 2 and 3, the second step involves the application of a "water-rinsable, solvent-miscible spray," whereas, according to claim 1, the second step utilizes a "water-rinsable, emulsifying spray." Foster discloses the application of "soap or soap-like detergent material" [Foster p. 1, lines 26, 27; R. 238], a "detergent material" [Foster's claims 1-4, 9 and 10], and a "cleaning material" [Foster's claim 8].

According to the patent in suit, it is the purpose of the patented second step "to render the solvent-sealant solution in the tank water rinsable" [Whitcomb patent column 4, lines 29, 30; R. 228], or "restores the film to its initial solvent solution" [column 4, lines 41, 42] in order that "water may be employed for rinsing out the emulsified solution" [column 4, lines 31, 32]. According to Foster, it is the purpose of the like step "to effect a combining, mixing or emulsifying" [Foster patent p. 1, lines 32-34;

R. 238] of whatever it is that is "on the surface to be cleaned, so that by the further application of . . . water, a substantially cleaned surface will result" [p. 1, lines 35-38]; the substantially cleaned surface results because the emulsified mixture "is readily washed off with water" [p. 3, lines 25, 26; R. 240].

The substantial identity of the method steps, their purposes, and the results thereby achieved is clear—so clear that no *genuine* issue is raised by a self-serving affidavit asserting that the spray used in the patented second step is not soapy and that a soapy solution would not serve the purpose. Such an assertion should be ignored as completely as an assertion that black is white.

The Whitcomb affidavit [R. 87] asserts [R. 96] that "soap or a soapy solution is not solvent miscible," and that the use thereof would "produce just the opposite results from those desired" [R. 97]. It is important to note that, genuine or not, the only issue raised by this assertion is whether Foster's soap is the same as the material called for by Whitcomb's claims 2 and 3.

What the Whitcomb affidavit does not assert is even more important; he does not assert that a spray of soap or of a soapy solution is not a "water-rinsable, emulsifying spray" (claim 1 of the patent in suit), and he does not assert that Foster's "soap-like detergent material," or "detergent material," or "cleaning material" is unlike the materials specified in the claims of the patent in suit, and he does not assert that these other materials of Foster would not work. In short, as to these other materials there is no dispute, and the trial court was required only to determine that Appellee was entitled to a judgment as a matter of law.

Whitcomb Affidavit Must Be Disregarded Because the Patentee Is Estopped to Take a Position Antagonistic to the Validity of His Patent.

If Whitcomb's affidavit is to be believed, he makes assertions that invalidate claims 3 through 8 of his patent. This being directly contrary to the averments of the oath accompanying his patent application and being in derogation of the property (the patent) transferred to his assignee (Appellant), Whitcomb is estopped now to make such assertions; his affidavit must be disregarded. (*U. S. Appliance Corp. v. Beauty Shop Supply Co., Inc.* (C. A. 9), 121 F. 2d 149.)

That part of the Whitcomb affidavit [R. 96, 97] which is quoted as footnote 3 to the Court's opinion of December 22 asserts that the so-called "second step" is essential to the successful practice of the invention, and that to follow the solvent spray with a water spray would cause the sealant to be re-set, rather than removed. Thus, according to Whitcomb's affidavit, to omit the second step is to render the process inoperative—yet this is what claims 4 through 8 do; each one of these claims calls for following the solvent spray with a water spray. Claims that define an inoperative process are invalid.

Not only is Whitcomb estopped to take such a position, but the inherent improbability of such assertions requires them to be disregarded, and this includes those concerning the soap or soapy solution.

When the Whitcomb affidavit is disregarded as it should be, it is seen that there does not exist any genuine issue as to any material fact which would preclude the trial court from entering a summary judgment. The judgment below should be affirmed.

It Was Not Improper for the Trial Court to Conclude as a Matter of Law That the Patented Method Lacked Invention.

According to *Bergman v. Aluminum Lock Shingle Corp. of America,* 251 F. 2d 801 (which this Court attempted to follow), the nature of the prior art and the nature of what the patentee did to improve upon it are questions of fact; whether what the patentee did is to be called an invention is a question of law. However, in the case at bar, the Court held erroneously that the trial court had resolved against the contested patent genuine issues of material fact which had been presented as to the prior art and the teaching of the Whitcomb patent. This conclusion was predicated upon the previously discussed disputes centering around the Foster patent.

In deciding that the Whitcomb patent in suit lacked invention, the trial court did not resolve any genuine issues of material fact, as will be seen from the following explanation:

The "Memorandum of Decision" filed December 11, 1957, was incorporated by reference into the trial court's findings of fact [Finding No. 26, R. 152]. One of the findings thus incorporated is the following:

> "So in the case at bar, even if the disclosures of the *non-cited-prior-art patents* be said to fall short of complete anticipation, *they* still serve upon the motion for summary judgment to negative invention, and thus to render invalid the patent in suit since, as has been shown, no presumption of validity can subsist as to the non-cited-prior art patents.
>
> "This alone is sufficient to dispose of the case on the merits." [R. 144.] (Emphasis added.)

The Foster patent No. 1,141,243, discussed by this Court in its opinion and as to which this Court concluded that the Whitcomb affidavit raised an issue of fact, was one of the patents cited by the Patent Office [see Finding No. 10, R. 148]; it was not one of the "non-cited-prior-art patents" referred to by the trial court in the above quotation and listed in its Finding No. 12 [R. 149]. Pursuant to the foregoing, the trial court concluded, as a matter of law:

> "The patent in suit, and each of its claims, are invalid and void, for want of invention over the prior art." [Conclusion of Law No. 4, R. 153.]

This conclusion was reached independently of any alleged question of fact concerning the Foster patent; it was expressly based upon a collection of prior art patents which did not include the Foster patent. Thus, the trial court's conclusion that Whitcomb lacked invention involved only a question of law which it was proper to decide by summary judgment.

Conclusion.

From the foregoing it clearly appears (1) that the Whitcomb affidavit does not raise any *genuine* issue of fact; (2) that the substantial identity of the method steps, their purposes, and the results thereby achieved by the Foster patent and the patent in suit is so clear that a genuine issue of fact cannot be raised by an affidavit which merely denies the truth of a self-evident proposition; (3) that the alleged issue of fact raised by the Whitcomb affidavit applies only to two or three of the eight claims of the patent in suit; (4) that the Whitcomb affidavit must be disregarded because of estoppel and because of the inherent improbability of the assertions

therein made; and (5) that resolution of the issue allegedly raised by the Whitcomb affidavit was not a predicate to the trial court's conclusion of law that the patented method lacked invention—that conclusion was not based upon any finding of fact regarding the allegedly disputed issue.

For the reasons stated above, Appellee requests that a rehearing be granted and that on such rehearing the judgment of this Court be revised to affirm the judgment of the court below.

Dated this 20th day of January, 1959.

Respectfully submitted,

FULWIDER, MATTINGLY & HUNTLEY,

and

WALTER P. HUNTLEY,

By WALTER P. HUNTLEY,

Attorneys for Appellee.

Certificate.

I hereby certify that the foregoing Petition for Rehearing is not presented for the purpose of delay but is filed in good faith and is, in the judgment of counsel, well founded in law and proper to be filed herein.

Dated this 20th day of January, 1959.

WALTER P. HUNTLEY,

Attorney for Appellee.